

B. REMARKS

The Examiner is thanked for the performance of a thorough search. In this reply, Claim 28 has been amended and new Claims 29-76 have been added. Hence, Claims 1-76 are pending in this application. The amendments to the claims and the new claims do not add any new matter to this application. Furthermore, the amendments to the claims were made to improve the readability and clarity of the claims and not for any reason related to patentability. All issues raised in the Office Action mailed January 26, 2004 are addressed hereinafter.

OBJECTION TO DRAWINGS

The drawings were objected to on the basis that FIG. 6 is unfocused and unreadable. New formal drawings are submitted herewith, including a FIG. 6 that is focused and readable. In view of the new formal drawings, reconsideration and withdrawal of the objection to the drawings is respectfully requested.

REJECTION OF CLAIMS 1-12 AND 14-28 UNDER 35 U.S.C. § 102(e)

Claims 1-12 and 14-28 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Blumberg et al.*, U.S. Patent Application Publication No. US 2003/0140315 A1 (hereinafter “Blumberg”). It is respectfully submitted that Claims 1-12 and 14-28 are patentable over *Blumberg* for at least the reasons provided hereinafter.

CLAIM 1

Claim 1 recites a method for previewing an electronic document that requires:

“generating the electronic document at a client;
transmitting document information associated with the electronic document from the client to a printing device;
generating preview document data at the printing device based on the document information and a set of one or more specific characteristics associated with the

printing device, wherein the set of one or more specific characteristics are unavailable at the client;
transmitting the preview document data to the client from the printing device; and
previewing the electronic document at the client based on the preview document data received from the printing device.”

It is respectfully submitted that Claim 1 includes one or more limitations that are not taught or suggested by *Blumberg*. For example, Claim 1 requires “generating preview document data at the printing device based on the document information and a set of one or more specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client.” *Blumberg* describes that the Virtual Builder software may be implemented on client computers, server computers, or both client computers and server computers. To the extent that the Virtual Builder software of *Blumberg* generates “preview document data” as recited in Claim 1, it is in the context of the Virtual Builder software generating preview data on a client computer and/or a server computer. There is no mention or suggestion in *Blumberg* that the client or server computers, on which components of the Virtual Builder software might be implemented, contain any printing capabilities. It is therefore respectfully submitted that the client and server computers mentioned in *Blumberg* are not “printing devices” as recited in Claim 1. Furthermore, the preview document data must be generated based upon one or more specific characteristics that are associated with the printing device and unavailable at the client. Accordingly, it is respectfully submitted that the limitation of “generating preview document data at the printing device based on the document information and a set of one or more specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client” required by Claim 1 is not in any way taught or suggested by *Blumberg* and that Claim 1 is therefore patentable over *Blumberg*.

CLAIMS 2-12 AND 14-18

Claims 2-12 and 14-18 all depend from Claim 1 and include all of the limitations of Claim 1. It is therefore respectfully submitted that Claims 2-12 and 14-18 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 1. Furthermore, it is respectfully submitted that Claims 2-12 and 14-18 recite additional limitations that independently render them patentable over *Blumberg*.

CLAIM 19

Claim 19 requires the limitation of “generating preview document data at the printing device based on the document information and a set of one or more specific characteristics associated with the printing device.” As set forth herein with respect to Claim 1, there is no mention or suggestion in *Blumberg* that the client or server computers, on which components of the Virtual Builder software might be implemented, contain any printing capabilities. Thus, the client and server computers mentioned in *Blumberg* are not “printing devices” as recited in Claim 1. It is therefore respectfully submitted that Claim 19 includes one or more limitations that are not in any way taught or suggested by *Blumberg* and is therefore patentable over *Blumberg*.

CLAIMS 20-25

Claims 20-25 all depend from Claim 19 and include all of the limitations of Claim 19. It is therefore respectfully submitted that Claims 20-25 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 19.

CLAIMS 26-28

Claims 26-28 recite limitations similar to Claim 1, except in the context of a computer-readable medium, a system and a document preview apparatus. It is therefore respectfully submitted that Claims 26-28 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 1.

In view of the foregoing, it is respectfully submitted that Claims 1-12 and 14-28 are patentable over *Blumberg*. Accordingly, reconsideration and withdrawal of the rejection of Claims 1-12 and 14-28 under 35 U.S.C. § 102(e) as being anticipated by *Blumberg* is respectfully requested.

REJECTION OF CLAIM 13 UNDER 35 U.S.C. § 103(a)

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Blumberg* in view of *Bando*, U.S. Patent No. 6,449,053. It is respectfully submitted that Claim 13 is patentable over *Blumberg* and *Bando*, alone or in combination, for at least the reasons provided hereinafter.

Claim 13 depends from Claim 1 and includes all of the limitations of Claim 1. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Blumberg*. It is also respectfully submitted that these limitations are also not taught or suggested by *Bando*. For example, Claim 13 requires “generating preview document data at the printing device based on the document information and a set of one or more specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client.” *Bando* describes a printing system with a RIP server that converts PDL data into raster image data. There is no description in *Bando* of a printing device configured to generate preview document data as required by Claim 13. It is

therefore respectfully submitted that Claim 13 is not in any way taught or suggested by Bando. Accordingly, it is respectfully submitted that Claim 13 includes one or more limitations that are not taught or suggested by *Blumberg* and Bando, alone or in combination, and is therefore patentable over *Blumberg* and *Bando*. Accordingly, reconsideration and withdrawal of the rejection of Claim 13 under 35 U.S.C. § 103(a) as being unpatentable over *Blumberg* in view of *Bando* is respectfully requested.

NEW CLAIMS 29-76

New Claims 29-45 contain limitations similar to Claims 2-18, except in the context of computer-readable media. It is therefore respectfully submitted that new Claims 29-45 are patentable for at least the reasons set forth herein with respect to Claims 2-18.

New Claims 46-62 contain limitations similar to Claims 2-18, except in the context of apparatuses. It is therefore respectfully submitted that new Claims 46-62 are patentable for at least the reasons set forth herein with respect to Claims 2-18.

New Claims 63-69 contain limitations similar to Claims 19-25, except in the context of computer-readable media. It is therefore respectfully submitted that new Claims 63-69 are patentable for at least the reasons set forth herein with respect to Claims 19-25.

New Claims 70-76 contain limitations similar to Claims 19-25, except in the context of apparatuses. It is therefore respectfully submitted that new Claims 70-76 are patentable for at least the reasons set forth herein with respect to Claims 19-25.

It is respectfully submitted that all of the pending claims are in condition for allowance and the issuance of a notice of allowance is respectfully requested. If there are any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Date: _____

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

On 4-20, 2004 By Shirley Jones